

08 NOV 2007



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In re Application of
SINGH-GILL, et al.
Application No.: 10/580,147
PCT No.: PCT/NZ04/00293
Int. Filing Date: 18 November 2004
Priority Date: 18 November 2003
Attorney Docket No.: AJPARK38.001APC
For: SYNTHETIC MOLECULES HAVING IMMUNE
ACTIVITY

DECISION ON
REQUEST UNDER
37 CFR 1.497(d)

This decision is in response to applicant's "REQUEST TO CORRECT INVENTORSHIP" filed 24 October 2007 in the United States Patent and Trademark Office (USPTO). The request is being considered pursuant to 37 C.F.R. 1.497(d). Applicant has provided payment of the \$130.00 petition fee.

BACKGROUND

On 18 November 2004, applicant filed international application PCT/NZ0400293, which claimed priority of an earlier application filed 18 November 2003. A copy of the international application was communicated to the United States on 02 June 2005. Pursuant to 37 CFR 1.495, the thirty-month period for paying the basic national fee in the United States was set to expire at midnight on 18 May 2006.

On 18 May 2006, applicant filed a transmittal letter for entry into the national stage in the United States, which was accompanied by the requisite basic national fee as required by 35 U.S.C. 371(c)(1) and a First Preliminary Amendment.

On 30 March 2007, applicant filed an executed declaration of the inventors which included an additional inventor, Gavin Painter who was not identified as an inventor on the published international application.

On 24 August 2007, applicant was mailed a "NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371" (Form PCT/DO/EO/905) informing applicant of the need to provide an oath or declaration of the inventors, in compliance with 37 CFR 1.497(a) and (b), identifying the application by the International application number and international filing date. The notification pointed out the addition of inventor Painter.

On 24 October 2007, applicant filed the present petition to add Gavin Painter as an inventor in the above-identified application.

DISCUSSION

37 CFR 1.497(d) [formally, 37 CFR 1.48] states in part: "If the oath or declaration filed pursuant to 35 U.S.C. 371(c)(4) and this section names an inventive entity different from the inventive entity set forth in the international application...applicant must submit:

- (1) a petition including a statement from each person being added or deleted as an inventor that the error in inventorship occurred without any deceptive intention on his or her part;
- (2) an oath or declaration by the actual inventor(s) as required by 37 CFR 1.63;
- (3) the fee set forth in 37 CFR 1.17(h); and
- (4) if an assignment has been executed by any of the original named inventors, the written consent of the assignee in compliance with 37 CFR 3.73(b).

Applicant has satisfied items (1)-(3). However, applicant has not provided the written consent of the assignee in compliance with 37 CFR 3.73(b). In light of the above, it is not possible to grant applicant's petition at this time.

CONCLUSION

For the reasons above, applicant's request under 37 CFR 1.497(d) is **DISMISSED** without prejudice.

Applicant is hereby afforded **TWO (2) MONTHS** from the mail date of this decision to file any request for reconsideration. Any reconsideration request should include a cover letter entitled, "Renewed Petition Under 37 CFR 1.497(d)." No additional petition fee is required. Extensions of time may be obtained under 37 CFR 1.136(a).

Any further correspondence with respect to this matter should be directed to Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.


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